

REMARKS

Status of the Claims

Claims 1-5 and 21-23 are pending in the present continued prosecution application. Claims 1 and 21 are the only independent claims. Claims 1-5 and 21-23 of the present continued prosecution application were rejected in the February 4th Office Action for prior application U.S.S.N. 09/349,806.

Rejections Under 35 U.S.C §103(a)

The February 4th Office Action rejected claims 1-5 and 21-23 under 35 U.S.C. § 103(a) as allegedly unpatentable over United States Patent No. 6,177,921 B1 to Comiskey et al. ("Comiskey") or United States Patent No. 6,323,989 B1 to Jacobson et al. ("Jacobson") in combination with United States Patent No. 5,208,686 to Fergason ("Fergason '686") or United States Patent No. 5,345,322 to Fergason ("Fergason '322").

Independent claim 1 recites a method of manufacturing a color electrophoretic display by providing a substrate disposed with at least two electrodes. A first plurality of electrophoretic display elements are selectively deposited in substantial registration with a first electrode. Each of the first plurality of display elements comprises a capsule containing a plurality of a first species of particles that are responsive to a first applied electric field and have a first optical property. A second plurality of electrophoretic display elements are selectively deposited in substantial registration with a second electrode. Each of the second plurality of display elements comprises a capsule containing a plurality of a second species of particles that are responsive to a second applied electric field and have a second optical property.

Independent claim 21 recites a method of manufacturing an electrophoretic display by providing a substrate and selectively depositing upon the substrate at least two electrodes. A first plurality of electrophoretic display elements are selectively deposited in substantial registration with the first electrode. Each of the first plurality of display elements comprises a capsule containing a plurality of a first species of particles that are responsive to a first applied electric field and have a first optical property. A second plurality of electrophoretic display elements are

selectively deposited in substantial registration with the second electrode. Each of the second plurality of display elements comprises a capsule containing a plurality of a second species of particles that are responsive to a second applied electric field and have a second optical property.

Applicants submit that Fergason '686 and Fergason '322, either alone or in proper combination, fail to teach or suggest Applicants' claims 1 and 23 as a whole because Fergason '686 and Fergason '322 do not teach or suggest manufacturing a color electrophoretic display with a substrate having at least two electrodes disposed thereon. Further, Fergason '686 and Fergason '322 fail to teach or suggest depositing a first plurality and a second plurality of display elements in substantial registration, respectively, with the first electrode and second electrode, each display element comprising a capsule containing a plurality of particles as set forth in Applicants' claims 1 and 21. As a result, Fergason '686 and Fergason '322 fail to teach or suggest every element of claims 1 and 21. Accordingly, Applicants submit that claims 1 and 21, and claims 2-5 and 21-23 that depend respectively therefrom, are novel and non-obvious over Fergason '686 and Fergason '322.

Applicants further submit that Comiskey and Jacobson, either alone or in combination with Fergason '686 and Fergason '322, fail render claims 1-5 or claims 21-23 obvious because Comiskey and Jacobson do not qualify as prior art to the present continued prosecution application for rejections based on 35 U.S.C. § 103(a). As a result, Comiskey and Jacobson cannot remedy the deficiencies of Fergason '686 and Fergason '322 to render claims 1-5 and 21-23 obvious.

Specifically, Applicants note that Comiskey and Jacobson could qualify as prior art only under 35 U.S.C. § 102(e), and submit that Comiskey and Jacobson are disqualified as prior art under 35 U.S.C. § 103(c). See, also, MPEP 706.02(I), 715.01. The subject matter of Comiskey and Jacobson and the claimed invention of the instant application were, at the time the invention was made, owned by E Ink Corporation or subject to an obligation of assignment to E Ink Corporation. More specifically, common ownership by E Ink Corporation of the instant application and U.S. Patent No. 6,177,921 B1 to Comiskey et al. for purposes of 35 U.S.C. § 103(c) is established by an assignment recorded at Reel 9675, Frame 0940, the assignment dated no later than December 17, 1998, that conveys the entire rights in U.S. Patent No. 6,177,921 B1 to E Ink Corporation; common ownership by E Ink Corporation of the instant

application and U.S. Patent No. 6,323,989 B1 to Jacobson et al. for purposes of 35 U.S.C. § 103(c) is established by: (1) an assignment recorded at Reel 10750, Frame 0857, the assignment dated no later than June 22, 2000, that conveys the entire rights in U.S. Patent No. 6,323,989 B1 to E Ink Corporation; and by (2) an assignment recorded at Reel 10720, Frame 0172, the assignment dated no later than October 12, 1999, that conveys the entire rights in the instant application to E Ink Corporation. Accordingly, Applicants respectfully request disqualification of Comiskey and Jacobson as prior art to the instant application for purposes of rejections based on 35 U.S.C. 103(a).

Applicants thus submit that claims 1 and 21 are novel and non-obvious because neither Ferguson '686 nor Ferguson '322, either alone or in proper combination, teach or suggest all elements of Applicants' claims 1 and 21. Consequently, Applicants submit that claims 2-5 and 22-23 are novel and non-obvious because they depend from novel and non-obvious base claims 1 and 21 respectively.


CONCLUSION

In view of the foregoing, Applicants respectfully submit that claims 1-5 and 21-23 are novel, non-obvious and are in condition for allowance.

If, in the Examiner's opinion, a telephonic interview would serve to clarify issues and expedite the prosecution of the present application, the undersigned attorney would welcome the opportunity to discuss any outstanding issues, and to work with the Examiner toward placing the application in condition for allowance.

Respectfully submitted,

Date: May 6, 2002
Reg. No. 47, 411
Tel. No. (617) 248-7102
Fax No. (617) 248-7100



Michael J. Bastian
Attorney for Applicants
Testa, Hurwitz, & Thibeault, LLP
High Street Tower
125 High Street
Boston, MA 02110